

REMARKS

Applicants have amended their claims hereto to better clarify their invention. Claims 1, 11, and 21, are amended herein to recite a first information storage and retrieval system comprising a plurality of host adapters, at least one host computer interconnected with at least one of said plurality of host adapters, a cache, a plurality of device adapters, a plurality of disk drives interconnected with said plurality of device adapters. Support can be found in the Specification on Page 8 at Lines 10-12 which reads "In certain embodiments, Applicants' primary information storage and retrieval system comprises information storage and retrieval system 100 (FIG. 1). Further support can be found in the Specification on Page 9 at Lines 3-19. Further support can be found in FIG. 1.

Claims 1, 11, and 21, are amended herein to recite

ascertaining, for each value of (j), if the (j)th PPRC adapter is in communication with said second information storage and retrieval system, wherein (j) is greater than or equal to 1 and less than or equal to (N); and

operative if the (j)th PPRC adapter is in communication with said second information storage and retrieval system, including said (j)th PPRC adapter as one of (M) tested adapters, wherein (M) is less than or equal to (N).

Support can be found in steps 440, 450, and 470 of FIG. 4. Support can further be found in the Specification at Page 12 / Line 9 through Page 13 / Line 9, and at Page 14 / Lines 15-18 which reads "As those skilled in the art will appreciate, the number of tested adapters, i.e. (M), is less than or equal to (N), i.e. the total number of PPRC adapters disposed in the primary information storage and retrieval system."

No new matter has been entered. Reexamination and reconsideration of the application, as amended, is respectfully requested.

Claims 1-30 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/779,215. Upon the allowance of one of more claims in the instant Application, and upon the allowance of one or more claims in Serial No. 10/779,215, Applicants will file a Terminal Disclaimer whereunder common ownership will be maintained and whereunder the two patents will have the same term.

Claims 1-30 stand rejected under 35 USC 112, first paragraph and second paragraph because the Specification does not define "PPRC" or bitmap. Applicants' claims, as amended herein, do not recite the term bitmap.

The Examiner asserts, *inter alia*, that "although the specification mentions the term "peer to peer remote copy," it fails to equate that term to "PPRC" thus it fails to describe what the acronym stands for." Applicants respectfully submit that a person having ordinary skill in the art would understand that the designation "PPRC" stands for peer-to-peer remote copy.

A person having ordinary skill in the art is presumed to have knowledge of all applicable prior art. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 U.S.P.Q. 603 (Fed.Cir. 1984). Applicants direct the Examiner's attention to United States Patent No. 6,131,148 entitled "Snapshot copy of a secondary volume of a PPRC pair." Clearly, the title of the '148 Patent includes the designation "PPRC." The '148 Patent was filed on January 26, 1998 and issued on October 10, 2000. Thus, the '148 Patent issued before the filing date of the instant Application. This being the case, a person having ordinary skill in the

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art is presumed to know of the '148 Patent. Applicants respectfully further submit that the title of the '148 Patent clearly demonstrates that the designation "PPRC" is well-known in the art, and that prior to the filing date of the instant Application a person having ordinary skill in the art would have understand the designation "PPRC."

Applicants further direct the Examiner's attention to Applicants direct the Examiner's attention to United States Patent No. 6,499,112 entitled "Automatic stand alone recovery for peer to peer remote copy (PPRC) operations." The '112 Patent was filed on March 28, 2000 and issued on December 24, 2002. Thus, the '112 Patent issued before the filing date of the instant Application. A person having ordinary skill in the art is presumed to know of the '112 Patent. Applicants respectfully further submit that the title of the '112 Patent clearly demonstrates that the designation "PPRC" is well-known in the art, and that prior to the filing date of the instant Application a person having ordinary skill in the art would have understand the designation "PPRC."

Applicants further direct the Examiner's attention to United States Patent No. 7,065,623 entitled "Bandwidth utilization in a PPRC system." Applicants respectfully submit that the title of the '623 Patent clearly demonstrates that the designation "PPRC" is well-known in the art, and that a person having ordinary skill in the art would understand the designation "PPRC."

Applicants further direct the Examiner's attention to United States Patent No. 7,127,636 entitled "Autonomic recovery of PPRC errors detected by PPRC peer." Applicants respectfully submit that the title of the '636 Patent clearly demonstrates that the designation "PPRC" is well-known in the art, and that a person having ordinary skill in the art would understand the designation "PPRC."

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The Examiner further asserts, *inter alia*, that "since the specification has not shown what exactly a PPRC adapter is . . . the subject matter fails to enable one of ordinary skill in the art to make/use the invention." Applicants respectfully disagree. The Specification recites, *inter alia*,

In the illustrated embodiment of FIG. 2, primary information storage and retrieval system 220 is capable of communicating with secondary information storage and retrieval system 230 via one or more of communication links 250, 260, and 270. In certain embodiments, communication links 250, 260, and 270, are each independently selected from the group consisting of a serial interconnection, such as RS-232 or RS-422, an Ethernet interconnection, a SCSI interconnection, a Fibre Channel interconnection, an ESCON interconnection, a FICON interconnection, a Local Area Network (LAN), a private Wide Area Network (WAN), a public wide area network, Storage Area Network (SAN), Transmission Control Protocol/Internet Protocol (TCP/IP), the Internet, or other interconnections and/or protocols as is known to those of skill in the art.

In the illustrated embodiment of FIG. 2, primary information storage and retrieval system 220 is capable of providing information to secondary information storage and retrieval system 230 via a first communication path which includes PPRC adapter 221, communication link 250, and PPRC adapter 231. PPRC adapter 221 includes microcode 222.

Page 6 at Lines 8-22.

Applicants respectfully submit that one of ordinary skill in the art would appreciate that PPRC adapter 221 comprises a hardware interconnection between communication link 250 and information storage and retrieval system 220, wherein that PPRC adapter operates uses microcode 222. This being the case, Applicants further respectfully submit that one of ordinary skill in the art can readily make and use the claimed invention without undue experimentation.

Claim 1 stands rejected under 35 USC 102(e) as being anticipated by Fujii et al. (U.S.

Pat. Application Pub. No. US 2004/0103210A1)

Claim 1 stands rejected under 35 USC 102(e) as being anticipated by Fnu et al. (U.S. Pat. Publication No. 2005/0063334).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987); MPEP 2131. Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989).

Fujii et al. fails to teach a method to provide information from a first information storage and retrieval system to a second information storage and retrieval system wherein the first information storage and retrieval system comprises (N) PPRC adapters, a plurality of host adapters, at least one host computer interconnected with at least one of said plurality of host adapters, a cache, a plurality of device adapters, a plurality of disk drives interconnected with said plurality of device adapters, and information, as recited in claim 1 as amended herein. This being the case, Applicants respectfully submit that claim 1, as amended herein, is not anticipated by Fujii et al.

Fnu et al. fails to teach a method to provide information from a first information storage and retrieval system to a second information storage and retrieval system wherein the first information storage and retrieval system comprises (N) PPRC adapters, a plurality of host adapters, at least one host computer interconnected with at least one of said plurality of host adapters, a cache, a plurality of device adapters, a plurality of disk drives interconnected with

said plurality of device adapters, and information, as recited in claim 1 as amended herein.

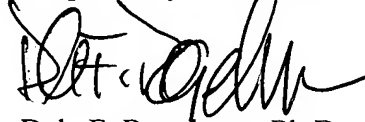
This being the case, Applicants respectfully submit that claim 1, as amended herein, is not anticipated by Fnu et al.

Claim 10 stands rejected under 35 USC 112, second paragraph, as being dependent on a canceled claim 1. Claim 10 is canceled. Herein.

Claim 11 stands rejected under 35 USC 112, first paragraph, because the Specification, while being enabling for the compositions of claim 12, does not reasonably provide enablement for other lathyrogens. Claim 11 is canceled herein.

Having dealt with all of the outstanding objections and/or rejections of the claims, Applicants submit that the application as amended is in condition for allowance, and an allowance at an early date is respectfully solicited. In the event there are any fee deficiencies or additional fees are payable, please charge them, or credit an overpayment, to our Deposit Account No. 502262.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 22, 2006 at Tucson, Arizona.

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